



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,144	08/23/2001	Robert Barry Wood	STL9833/40046.I50USUI	1721
7590	03/01/2006			EXAMINER CASIANO, ANGEL L
H. SANDERS GWIN, JR. SHUMAKER & SIEFFERT, P.A. 8425 SEASONS PARKWAY SUITE 105 ST. PAUL, MN 55125			ART UNIT 2182	PAPER NUMBER
			DATE MAILED: 03/01/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,144	WOOD, ROBERT BARRY
	Examiner Angel L. Casiano	Art Unit 2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 November 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 and 16-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-6 and 16-23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20050907</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- The present Office action is in response to Amendment dated 18 November 2005.
- Claims 1-6 and 16-23 are pending.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 07 September 2005 was filed after the mailing date of the Non-final Office action on 18 August 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 2182

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-6 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker, [MP3: The Definitive Guide, published March 2000] in view of Bruner et al. [US 6,212,588 B1].

Regarding claim 1, Hacker teaches a data storage device M133 player that makes use of IBM'S MicroDrive (see figure on page 4 of 10 as well as section 6.2.1.2 starting on page 3 of 10). The use of the MicroDrive in an M173 player reads on the claimed limitations: "a data disc rotatably mounted on a baseplate", "an actuator arm adjacent to the data disc carrying a transducer for reading data from and writing data to the data disc" as these are essential components to any MicroDrive as it nothing more than a miniature hard drive able to store data on its magnetic data disc. Without these claimed components, data

Art Unit: 2182

could not be written or read to/from the MicroDrive. As further proof that hard drives are utilized in an M133 player, Hacker teaches on page 2 of 10, section 6.2. 1, that just prior to press time (of this reference) a new player called Personal Jukebox has announced an MP3 player packing a 4.86 GB hard drive capable of storing around 100 CDs worth of music in a form factor only slightly larger than a traditional MP3 portable. A hard drive containing room for 4.86 GB of data means a portable hard drive with moving parts (servo controller, actuator arm, etc) is utilized.

Hacker further teaches a "memory storing an application program operably connected to the CPU, whereby the application program is run by the CPU". Table 6. 1 on page 9 of 10 shows M173 players have several programs installed including audible codecs essential to playing an M173 file as well as EQ controls program to adjust various EQ settings such as bass and treble. These programs are stored in a memory of the M133 player. Hacker also teaches an MP3 player (data storage device) that is within a 3 1/2 inch form factor as seen on Table 6.1. Table 6.1 also teaches an M133 player whose components are contained within a case.

However, the reference fails to explicitly teach "a PCB mounted to a baseplate and having a servo controller and CPU

mounted to the PCB". As for these limitations, Bruner et al. teaches a device including a PCB mounted as well as a servo controller. Furthermore, the reference also teaches a CPU mounted on the same circuit board (see Figure 2, "50"; col. 6, lines 12-16).

At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to obtain an improved integrated circuit operatively located in a host computer for controlling a mass storage device, as taught by Bruner et al. (see col. 2, lines 60-62).

As for claim 2, Hacker teaches an M173 player connected to a communication network comprising an input/output module communicating to a node connected to the communications network or LAN. A network by definition is an arrangement of components or nodes and interconnecting branches. Therefore, Hacker teaches an M173 player with parallel and USB modules used to connect to a computer for the transfer of data files as seen on page 1 of 10.

As for claim 3, Hacker teaches the utilization of a HTTP protocol to gather information from a website based on information on an M153 player.

As for claim 4, Hacker does not explicitly teach an input/output module including a video interface module operable to drive a video monitor via the communications network. As for this limitation, Bruner et al. teaches a video interface module operable to drive a video monitor (see col. 5, lines 41-43). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated above.

As for claim 5, Hacker teaches an MP3 player (data storage device) that is within a 3 1/2 inch form factor as seen on Table 6.1.

As for claim 6, Hacker does not explicitly teach a file system managing file data stored on the data disc, as claimed. As per these limitations, Bruner et al. teaches a manager system managing data stored on the disc (see "buffer manager", Abstract). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated above.

Regarding independent claim 16, the combination of references teaches the limitations corresponding to the data storage device as recited in claim 1. The present claim is a variation of claim 1. Furthermore, Burner et al. teaches running an operating system (see col. 9, 74-75 and 76-77) and memory storing application program (see col. 5, line 10). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated above.

As for claim 17, Burner teaches the memory stores the operating system and application program (see "program ROM 39") for use by the CPU (see Figure 1B). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated above.

Regarding independent claim 18, this is directed to an intelligent storage element. The combination of references teaches the limitations corresponding to the data storage device as recited in claim 1. The present claim is a variation of claim 1 and is therefore rejected under the same rationale.

As for claims 19-23, these constitute a variation of the claims previously presented and rejected. The combination of references teaches the limitations corresponding to the data storage device as recited in claims 2-6. The present claims are a variation of claims 2-6 and therefore are rejected under the same rationale.

Response to Arguments

5. Applicant's arguments with respect to claims 1-6 and 16-23 have been considered but are moot in view of the new ground(s) of rejection.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "more compact and efficient design" Page 7; "claim 18... may be implemented as an integrated component" Page 9) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 571-272-4142. The examiner can normally be reached on 9:00-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alc
February 13, 2006



KIM HUYNH
SUPERVISORY PATENT EXAMINER

2/16/06